



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,863	11/19/1999	INDU PARIKH	401930/SKYEPhARMA	7862

35437 7590 03/16/2007
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
666 THIRD AVENUE
NEW YORK, NY 10017

EXAMINER

KISHORE, GOLLAMUDI S

ART UNIT	PAPER NUMBER
----------	--------------

1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/443,863

Applicant(s)

PARIKH ET AL.

Examiner

Gollamudi S. Kishore, Ph.D

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-52, 54, 56-75, 77, 79-95, 97-104 and 108-131 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-52, 54, 56-75, 77, 79-95, 97-104 and 108-131 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment dated 12-22-06 is acknowledged.

Claims included in the prosecution are 50-52, 54, 56-75, 77, 79-95, 97-104 and 108-131.

In view of the amendments to the claims, the 112, second paragraph rejection is withdrawn.

Claim Rejections - 35 USC ' 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 50-52, 54, 56-75, 77, 79-95, 97-104 and 108-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/07414 (on record) in view of either Green (5,976,577) of record or Venkatesh (6,475,510).

WO discloses the same process of preparation for the rapidly dispersing oral dosage forms of hydrophobic compounds wherein the particles are coated with at least two surfactants; one of the surfactants is a phospholipid (surface modifying agent). The average particle sizes of the hydrophobic compound are less than 10 microns. The composition contains other claimed materials such as celluloses and mannitol. The process of preparation involves the mixing of the components (water insoluble active agent and the surface modifying agents) in an aqueous medium, sonicating it and lyophilizing the composition to form particles (note the abstract, page 2, line 25 through page 8, line 19, Examples and claims). WO further teaches that the lyophilized powders

Art Unit: 1615

can be converted into granules or tablets with the addition of binders and other excipients known in the art of tablet making (page 4, lines 14-17). What is lacking in the process of WO is the additional step of adding rapidly dispersible matrix-forming releasing agents to prepare rapidly disintegrating solid dosage form.

Green (5,976,577) discloses fast dispersing solid dosage forms of various drugs. The particles in Green are coated with polymers and lipid materials such as fatty acids (surfactants) and phospholipids. According to Green, the carrier material, which aids the rapidly disintegrating network, includes microcrystalline cellulose, mannitol, sorbitol and gelatin (abstract, col. 3, lines 43-60, col. 5, lines 30-48, col. 8, lines 20-31, Examples and claims, claim 12 in particular).

Venkatesh similarly discloses fast dispersing solid dosage forms of various drugs. The particles are coated with phospholipids in Venkatesh. According to Venkatesh, the carrier material includes mannitol, sorbitol and xylitol (abstract, col. 5, lines 8-39, col. 6, lines 9-35, col. 7, lines 39-67 and examples).

To add the step of the addition of bulking and releasing agents such as mannitol, microcrystalline cellulose and sorbitol in the method of preparation of WO, if the desired goal is to make the tablets of WO as rapidly disintegrating tablets, would have been obvious to one of ordinary skill in the art at the time the invention was made since the references of Green and Venkatesh each teach that these agents would enable the tables to disintegrate rapidly.

Applicant's arguments have been fully considered, but are not persuasive.

Applicant argues that the present invention is directed to an improvement in the dispersibility of micronized particles through the specific selection of excipients and the micronized particles as disclosed in WO 98/07414 are required in the practice of the present invention. Applicant further argues that the invention disclosed by WO 98 is a process of making non-aggregating submicron sized primary microparticles and the particles so produced. According to applicant, WO is concerned with suspensions and all of the exemplified formulations are suspensions in aqueous media. Further according to applicant, whereas WO 98 **does suggest** that the suspensions can be dried and formed into capsules or tablets, nothing is mentioned regarding the properties of these capsules when exposed to aqueous media. Applicant also argues that rapid disintegration time was not taught or even suggested by WO 98 and that there is no teaching that at least two, rapidly dispersible, matrix forming agents are mixed with the micro particles. These arguments are not persuasive. WO 98 teaches the coating of the particles with two surfactants including phospholipids and is suggestive of the preparation of dried forms such as tablets as recognized by applicants themselves. The secondary references of Green clearly teaches that one can form rapidly dispersing solid dosage forms using particles coated by surfactants and the use of carrier material, which aids the rapidly disintegrating network, includes microcrystalline cellulose, mannitol, sorbitol and gelatin to obtain fast disintegrating solid forms. Similarly Venkatesh teaches phospholipid coated particles and carriers mannitol, sorbitol and Xylitol for fast dispersing solid dosage forms of various drugs. Therefore, to prepare the

Art Unit: 1615

solid dosage forms suggested by WO as rapidly disintegrating solid dosage forms if such forms are desired would have been obvious to one of ordinary skill in the art since the references of Green and Venkatesh teach that one can prepare rapidly disintegrating solid dosage forms can be prepared by using the same surfactants and same carriers. Mixing two-carrier material to reach the same goal is within the skill of the art and also from the guidance provided by the secondary references.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 50-52, 54, 56-75, 77, 79-95, 97-104 and 108-131 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,922,355 in combination with either Green (5,976,577) or Venkatesh (6,475,510). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons. Claims in the said patent are drawn to a process of preparing microparticles of water insoluble drugs mixing the drug, a phospholipid and another surfactant and applying

Art Unit: 1615

energy to reduce the particle sizes. Claims in instant application recite the same steps with further inclusion of a step of adding bulking /releasing agents to prepare rapidly disintegrating solid preparations. What is lacking in the patented claims reciting 'comprising the steps of' is the addition of bulking/releasing agents to prepare rapidly disintegrating solid dosage forms.

Green (5,976,577) discloses fast dispersing solid dosage forms of various drugs. The particles in Green are coated with polymers and lipid materials such as fatty acids (surfactants) and phospholipids. According to Green, the carrier material, which aids the rapidly disintegrating network, includes microcrystalline cellulose, mannitol, sorbitol and gelatin (abstract, col. 3, lines 43-60, col. 5, lines 30-48, col. 8, lines 20-31, Examples and claims, claim 12 in particular).

Venkatesh similarly discloses fast dispersing solid dosage forms of various drugs. The particles are coated with phospholipids in Venkatesh. According to Venkatesh, the carrier material includes mannitol, sorbitol and xylitol (abstract, col. 5, lines 8-39, col. 6, lines 9-35, col. 7, lines 39-67 and examples).

To add the step of the addition of bulking and releasing agents such as mannitol, microcrystalline cellulose and sorbitol in the method of preparation of 5,922,355, if the desired goal is to make rapidly disintegrating tablets, would have been obvious to one of ordinary skill in the art at the time the invention was made since the references of Green and Venkatesh each teach that these agents would enable the tables to disintegrate rapidly. Instant fenofibrate is deemed to be anticipated by the patented claims, which recite generic water insoluble drug.

Art Unit: 1615

5. Claims 50-52, 54, 56-75, 77, 79-95, 97-104 and 108-131 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-25, 45-47, 52-53, 55-56, 65 and 101-119 of copending Application No. 10/260,788 in combination with either Green (5,976,577) or Venkatesh (6,475,510). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons. Claims in the said patent are drawn to a process of preparing microparticles of water insoluble drugs mixing the drug, a phospholipid and another surfactant and applying energy to reduce the particle sizes. Claims in instant application recite the same steps with further inclusion of a step of adding bulking /releasing agents to prepare rapidly disintegrating solid preparations. What is lacking in the claims of the copending application reciting 'comprising the steps of' is the addition of bulking/releasing agents to prepare rapidly disintegrating solid dosage forms.

Green (5,976,577) discloses fast dispersing solid dosage forms of various drugs. The particles in Green are coated with polymers and lipid materials such as fatty acids (surfactants) and phospholipids. According to Green, the carrier material, which aids the rapidly disintegrating network, includes microcrystalline cellulose, mannitol, sorbitol and gelatin (abstract, col. 3, lines 43-60, col. 5, lines 30-48, col. 8, lines 20-31, Examples and claims, claim 12 in particular).

Venkatesh similarly discloses fast dispersing solid dosage forms of various drugs. The particles are coated with phospholipids in Venkatesh. According to

Art Unit: 1615

Venkatesh, the carrier material includes mannitol, sorbitol and xylitol (abstract, col. 5, lines 8-39, col. 6, lines 9-35, col. 7, lines 39-67 and examples).

To add the step of the addition of bulking and releasing agents such as mannitol, microcrystalline cellulose and sorbitol in the method of preparation in the claims of said copending application, if the desired goal is to make rapidly disintegrating tablets, would have been obvious to one of ordinary skill in the art at the time the invention was made since the references of Green and Venkatesh each teach that these agents would enable the tables to disintegrate rapidly. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the copending application are drawn to the same process of preparation and the products resulting from said process and the process is directed to water insoluble drugs. 'Insoluble drugs' in said copending application anticipate instant species of water insoluble drug, fenofibrate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The double patenting rejections are maintained since applicant has neither provided arguments nor filed terminal disclaimers.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 1615

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gollamudi S. Kishore, Ph.D whose telephone number is (571) 272-0598. The examiner can normally be reached on 6:30 AM- 4 PM, alternate Friday off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Woodward Michael can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 1615

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gollamudi S Kishore, Ph.D
Primary Examiner
Art Unit 1615

GSK